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EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/648,102

Applicant(s)

COOPER, JONATHAN D.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27,36-45,47,48 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27,36-45,47,48 and 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Status of Claims*

1. Applicant has canceled claims 28-35, 46 and 49 and amended claims 47 and 50 in the amendment filed 04 June 2003. Thus, claims 1-27, 36-45, 47-48 and 50-58 remain pending and are again presented for examination.

### *Drawings*

2. This application was filed with informal drawings that are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10, 12-13, 16-23, 25, 27, 38, 40-45, 47-48 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by March, U.S. Patent Application Publication No. US 2002/0016763 A1.

As per Claims 1, 18-19 and 38, March discloses a computer system to facilitate secure money transfer transactions between sender consumers and recipient consumers, said computer system comprising:

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- a transaction control center for receiving information from a sender consumer in order to initiate a secure money transfer with a recipient consumer (Figure 1; 0040; 0044; 0054);
- a computer readable medium configured to enable the completion of a secure money transfer when utilized by a recipient consumer (0060);
- a transaction database configured to store transaction data associated with said secure money transfer, said transaction data associated with said secure money transfer including consumer transaction information, a delivery address through which said recipient consumer can obtain said configured computer readable medium (0053; 0060), and a unique security identifier for said secure money transfer, said transaction database being in communication with said transaction control center (0054; 0058; 0061-0062); and
- a transaction fulfillment center being in communication with said transaction control center, said transaction fulfillment center controlling delivery of said computer readable medium utilized by said recipient consumer to complete said secure money transfer (0016; 0036; 0043; 0060).

As per **Claims 2 and 4**, March further discloses wherein the transaction control center includes a telemarketing operation capable of receiving a secure money transfer telephone order from said sender consumer or a web site available on the Internet (0041).

As per **Claim 3**, March further discloses a method for transferring funds and teaches that the sender is enabled to initiate a money transfer using an ATM (0041).

As per **Claims 5-6, 10 and 40-42**, March further disclose the use of one or more of a network of third party commercial vendors who are always available and who will hold the configured computer readable medium for the recipient consumer for pick up and for fulfilling the money transfer (0006; 0046-0047).

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As per **Claims 7-8 and 43**, March further discloses a telephone communication line and Internet communication between the recipient consumer which is used to activate the computer readable medium (Figure 1; 0047; 0048).

As per **Claim 9**, March further discloses wherein the computer readable medium is configured by storing a pre-assigned serial number associated with consumer transaction information (0043).

As per **Claims 12-13, 16-17 and 44-45**, March discloses computer implemented method for facilitating a secure money transfer transaction between a sender consumer and a recipient consumer, said computer implemented method comprising the steps of:

- a) obtaining transaction payment information associated with said sender consumer (0040; 0044; 0054);
- b) obtaining delivery address information for said recipient consumer (0053);
- c) defining a unique security identifier associated with said secure money transfer (0043);
- d) entering the information in steps a)-c) into the transaction database (0054; 0058; 0061-0062)
- e) assigning a serial number to the consumer transaction and information (0044);
- f) configuring a magnetically encoded computer readable medium to said secure money transfer, said computer readable medium utilized by said recipient consumer in completing said secure money transfer (0016; 0036; 0060) and;
- g) providing said recipient consumer with said unique security identifier (0043;) and;
- h) providing said configured computer readable medium to the recipient consumer (0036; 0047; 0060);
- i) enabling the recipient consumer to withdraw cash from financial networks using said configured computer readable medium and the unique security identifier (0036; 0046; 0060).

As per **Claims 20-21**, March further discloses a computer implemented method as recited in claim 12, wherein said acts a) - c) are accomplished via a telephone communication and global computer

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network (0041) between said sender consumer and a transaction control center, said transaction control center maintaining said consumer transaction information, said recipient consumer contact information, and said unique security identifier (0054; 0058; 0061-0062).

As per **Claims 22-23 and 25**, March further discloses wherein the unique security identifier is provided by the sender consumer (0043), the recipient activates the computer readable medium by conveying information through a voice or data transmission (0048).

As per **Claim 27**, March further disclose wherein a recipient consumer activates the computer readable medium by conveying information through a data transmission (0048).

As per **Claims 47**, March discloses an automated process for sending money from a first location to a second location comprising:

- a) receiving a request for a secure money transfer from a requestor (0040; 0044; 0054);
- b) receiving information associated with a recipient for the secure money transfer including an amount of the money transfer (0040; 0053; 0054);
- c) transferring the amount to a secure money transfer instrument (0016; 0036; 0060) and;
- d) assigning an authorization to the secure money transfer instrument and providing information enabling receipt of the secure money transfer instrument by the recipient wherein the authorization enables the recipient to use the secure money transfer instrument in automated teller machines (0043; 0046; 0048; 0060).

As per **Claim 48**, March further discloses wherein the authorization includes an access code provided independently of the secure transfer instrument for use with the ATM in order to receive money (0060).

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As per **Claim 54**, March discloses an automatic money transfer system for transferring money from a donor to a donee comprising:

a) an automated server system for facilitating the secure transfer of money from a donor to a donee, the automated server system being operative to allocate funds to a portable secure transfer instrument and to assign a security code to the instrument, the secure transfer instrument including machine readable information (0040; 0044; 0054; 0060);

b) a data storage device for recording the secure transfer (0054; 0058; 0061-0062);

c) a delivery system for providing the portable secure transfer instrument to the donee enabling the donee to access the funds from an ATM using the portable secure transfer instrument and the security code (0060; 0078).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11, 14-15, 24, 26, 36-37 and 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over March, U.S. Patent Application Publication No. US 2002/0016763 A1

As per **Claim 11**, March does not explicitly disclose an ATM on the physical premises, however, examiner submits that this would have been obvious to one having ordinary skill in the art at the time of applicant's invention since the vendor is distributing ATM cards.

As per **Claim 14**, March fails to specifically disclose wherein the act of determining contact information for the recipient includes the act of selecting the most appropriate delivery location by implementing an algorithm that returns the most appropriate delivery location based on criteria,

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comprising but not limited to: (a) the geographic location of recipient, (b) the desired hours of pick-up location, and (c) the desired features of pick-up location. However, examiner takes official notice that this would have been obvious to one having ordinary skill in the art. For example, it is known to use this type of algorithm for delivering any number of items to recipients such as business or personal packages or food items such as pizza delivery. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of March and include the ability to select the most appropriate delivery location based on any number of factors as is well known in the art to provide additional conveniences to the recipient so that he/she does not have to travel long distances to receive the item or can receive the item at any time of day.

As per **Claims 15 and 36-37**, March discloses a computer implemented method as recited in claim 12, wherein the said act of facilitating the withdrawal of cash by a recipient consumer configured computer readable medium further comprises the acts of:

- (a) entering the consumer transaction data in a transaction database (0054; 0058; 0061-0062).
- (b) entering the recipient consumer request into a transaction database, which may include a serial number for a configured computer readable medium (0048).
- (c) comparing the recipient consumer information with the stored consumer transaction data to determine if the recipient consumer information matches the consumer transaction information and if it is valid (0048);
- (d) if there is a match, then the transaction database associates the recipient consumer information with the consumer transaction data, records the transaction, and signals a financial network that the configured computer readable medium is enabled to withdraw cash from ATM networks (0048).

March fails to specifically disclose that if there is not a match the consumer transaction information then the transaction database requests new information from the recipient consumer, however, examiner takes Official Notice that this feature would have been obvious to one having ordinary skill in the art at the time of applicant's invention. It was typical for banking institutions to allow customers

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a certain number of tries to input the correct information in the event that they made a mistake during a keypad entry.

As per **Claims 24 and 26**, March fails to specifically disclose wherein a recipient consumer activates the computer readable medium by conveying information through a voice communication contact, however, examiner submits that this would have been obvious given the suggestion in March that voice response units may be used to access the services of the invention (0041) and further wherein the recipient may use an interactive terminal (0048). Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to allow the recipient to access the services through a voice communication contact in order to provide additional conveniences and flexibility to the recipient.

As per **Claim 39**, March further discloses wherein the magnetically encoded card contains a serial number either printed on the card (Figure 6) and wherein the purchaser may enable or activate the card by communicating with a transaction control center (0048), however fails to specifically disclose wherein a serial number is encoded in the magnetic strip. Examiner submits, however, that it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to encode the serial number in the magnetic strip as is conventionally known. March discloses that the card can be issued to the recipient using conventionally known card issuance techniques (0060).

7. Claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over March, U.S. Patent Application Publication No. US 2002/0016763 A1 in view of Corder et al, U.S. Patent No. 5,936,221.

As per **Claim 50**, March further discloses wherein the secure money transfer is used to transfer money from the requester located in a first country to a recipient located in a second country (0078). Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by March, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds

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may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of March and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

As per **Claims 51-52**, March discloses an automated process for sending money from a first location to a second location comprising:

- a) receiving a request for a secure money transfer from a requestor indicating a destination for the transfer and an amount for the transfer via a communications network (0040; 0044; 0053; 0054);
- b) transferring the amount to an ATM card (0016; 0036; 0060) and;
- c) assigning an authorization code to the ATM card (0060); and
- d) providing the ATM card to the destination such that recipient receives the ATM card enabling the recipient to withdraw funds from an ATM using the ATM card (0060).

Although it may have been obvious that the requestor may be capable of adding additional funds to the secure money transfer using the process as disclosed by March, this is not explicitly disclosed. Corder et al disclose a system and method for transferring value to a card and further disclose that additional funds may be added and transferred to the card via a communications network (Col. 2, lines 20-39). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of March and include the ability to add additional funds to the secure money transfer to provide a convenient method for the recipient to have access to additional funds when the original transfer amount is depleted.

8. Claim 53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over March, U.S. Patent Application Publication No. US 2002/0016763 A1 and Corder et al, U.S. Patent No. 5,936,221 as applied above and further in view of Picciallo, U.S. Patent No. 6,044,360

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As per **Claim 53**, March further discloses that the delivery address is the address of the recipient. March discloses that the recipients obtain the computer readable medium through card distributor sites. Picciallo discloses a third party credit card method wherein an account holder can initiate a transfer of funds to a recipient and further teaches that a computer readable medium is either issued to the account holder for delivery to the third party recipient or it may be issued directly to the third party recipient (Col. 11, lines 35-45). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of March and incorporate the ability to deliver the computer readable medium directly to the recipient as taught by Picciallo rather than requiring the recipient to physically visit a distribution site in order to provide additional conveniences to the recipients and reduce the amount of time to get access to the funds.

As per **Claim 55-57**, March further discloses wherein the security code is contained in machine readable information (0040; 0044; 0054; 0060), wherein the security code must be manually entered on the ATM by the donee in order for the donee to receive money (0060) and an automated communication system for providing the security code to the donee (0043).

9. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over March, U.S. Patent Application Publication No. US 2002/0016763 A1 and Corder et al, U.S. Patent No. 5,936,221 as applied above and further in view of Downing et al, U.S. Patent No. 5,963,647.

As per **Claim 58**, March and Corder et al fail to specifically disclose wherein the money is provided by the requestor in a first currency and provided to the recipient in a second currency, wherein the first currency and the second currency are of different nationalities. Downing et al disclose a method for transferring funds from an account to an individual and teach wherein the money is provided by the requestor in a first currency and provided to the recipient in a second currency, wherein the first currency and the second currency are of different nationalities (Col. 4, lines 38-42; Col. 7, lines 44-61). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the

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methods of March and Corder et al and incorporate the ability to transfer money using different currencies as taught by Downing et al in order to allow individuals to transfer money using any currency around the world as suggested by Downing et al (Col. 1, lines 55-67).

### ***Conclusion***

10. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Marcous et al discloses many features of applicant's invention, however, without the need to have a card to activate the dispensing terminal
- Stoutenburg et al disclose a method for performing money transfers through a TCP/IP network including establishing a desired amount to be transferred, establishing a code that corresponds to the transaction details and transmitting the code from the sender to the recipient
- Rizzo et al disclose a method for cash transfers that allows an originator to set up a transaction using a telephone or website and transfer money to a recipient who uses an ATM card to receive the funds
- Downing et al disclose a method for transferring funds from an account to an individual and teach that an originator can transfer an amount to a cash access file which can be accessed 24 hours a day wherein access is achieved by the recipient entering a codeword selected by the sender along with a transaction code and wherein the recipient can receive funds through an ATM even without using a card to access the system.

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- Ito et al disclose a method of transferring funds from a sender to a receiver using a communications network and e-mail.
- Farris et al disclose a method for transferring funds from a customer to a patron by depositing cash into a kiosk, providing a security code to the customer who then provides this code to a patron who inputs the code into a kiosk in order to receive the funds.
- Cucinotta et al disclose a method for holding and dispensing cash upon demand at a remote location
- Jennings et al disclose a method for transferring funds by allowing funds to be transferred instantly to an account so that they are available to a beneficiary
- Davis et al disclose a method for activating cards at the point of distribution.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

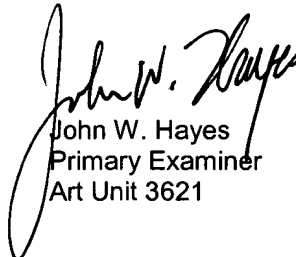
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"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington,  
VA, 7<sup>th</sup> floor receptionist.

  
John W. Hayes  
Primary Examiner  
Art Unit 3621

July 14, 2003